

REMARKS

The present application was filed on February 11, 2004 with claims 1-37. Claims 2 and 18 have been previously canceled. Claims 1, 3-17 and 19-37 remain pending. Claims 1 and 27-30 are the pending independent claims.

Claims 28 and 29 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1, 3-11, 13-16, 19-23 and 25-37 are rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent Application Publication No. 2007/0265962 (hereinafter "Bowe").

Claims 12, 17 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bowe in view of B. Medjahed et al., "Business-to-Business Interactions: Issues and Enabling Technologies," The VLDB Journal, vol. 12, no. 1, May 2003, pages 59-85 (hereinafter "Medjahed").

With regard to the §101 rejection, Applicants note that the present rejection is predicated on the Examiner's contention that the "content of claims 28 and 29 discloses functional descriptive material thus those independent claims are held non-statutory in accord with provisions of 35 U.S.C. 101." Applicants respectfully note that MPEP 2106.01 explicitly states that "[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized."

With regard to claim 28, Applicants respectfully submit that an article of manufacture for managing data associated with a given domain, comprising a machine readable medium containing one or more programs which when executed implement the steps of a patentable process, constitutes a proper claim of statutory subject matter. See, e.g., the above-quoted portion of MPEP 2106.01; see also *In re Beauregard*, 53 F.3d 1583; 35 USPQ2d 1383 (Fed. Cir. 1995), and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Nonetheless, Applicants have amended claim 28 without prejudice so as to recite a "computer readable storage medium" rather than a "machine readable medium."

With regard to claim 29, Applicants respectfully submit that the recited data store recited in claim 29 is "a physical or logical relationship among data elements, designed to support specific data

manipulation functions,” and thus is a data structure as described in MPEP 2106.01. MPEP 2106.01 further indicates that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components [of the computer which reads the medium] which permit the data structure’s functionality to be realized, and is thus statutory.” Claim 29 has been amended to recite an article of manufacture comprising a computer readable storage medium containing a data store, and is thus believed to be directed to statutory subject matter.

Support for the above amendments may be found in the specification at, for example, page 9, lines 14-16, with reference to FIG. 1; page 10, lines 21-24; and page 11, lines 18-21, both with reference to FIG. 2.

With regard to the §102 rejection, Applicants initially note that the Federal Circuit has recently reiterated that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102.” *Net MoneyIN Inc. v. VeriSign Inc.*, 545 F.3d 1359, 1369, 88 USPQ2d 1751, 1760 (Fed. Cir. 2008)

Applicants have amended independent claims 1 and 27-30 in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

Specifically, independent claim 1 has been amended to recite limitations directed to generating at least one flow graph using at least a portion of the maintained specifications; and determining a representation of a request from an application as a traversal of at least a portion of the at least one flow graph. Support for this amendment may be found in the specification at, for example, page 24, line 25, to page 28, line 4. Similar amendments have been made to independent claims 27-30.

Applicants respectfully submit that Bowe fails to disclose at least the newly-added limitations of independent claim 1 directed to generating at least one flow graph using at least a portion of the maintained specifications; and determining a representation of a request from an application as a traversal of at least a portion of the at least one flow graph.

Applicants have also chosen to amend claims 1 and 30 without prejudice solely in order to further clarify that the claims define patentable subject matter under the “machine-or-transformation” test discussed in, for example, *In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir., Oct. 30, 2008)), as well as the “useful, concrete, and tangible result” test discussed in, for example, *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), and *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994). More specifically, claims 1 and 30 has been amended so to clarify that the recited method, including the steps of generating at least one flow graph using at least a portion of the maintained specifications and determining a representation of a request from an application as a traversal of at least a portion of the at least one flow graph, are performed using a processor. These claims are therefore believed to satisfy at least the machine branch of the aforementioned “machine-or-transformation” test. See, e.g., *Bilski*, 88 USPQ2d at 1396 (“The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.”) Support for these amendments may be found in the specification at, for example, page 9, line 17, to page 11, line 21, with reference to FIGS. 1 and 2.

Dependent claims 3-17, 19-26 and 31-37 are patentable by virtue of their dependency from respective independent claims 1 and 30 and also recite patentable subject matter in their own right.

Moreover, Medjahed fails to supplement Bowe so as to teach or suggest the limitations of the independent claims as amended. As such, Applicants assert that amended claims 1 and 27-30, and the claims depending therefrom, are patentable over Bowe and Medjahed.

In view of the above, Applicants believe that amended claims 1, 3-17 and 19-37 are in condition for allowance, and respectfully request withdrawal of the present rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David E. Shifren', with a stylized, cursive script.

Date: January 29, 2009

David E. Shifren  
Attorney for Applicant(s)  
Reg. No. 59,329  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560  
(516) 759-2641